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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/645,660	08/24/2000	Jesus Mena	L9406-002	3538
7590 06/13/2006				
Patterson Belknap Webb & Tyler L L P Attn IP Department 1133 Avenue of the Americas New York, NY 10036			EXAMINER LEE, PHILIP C	
			ART UNIT 2152	PAPER NUMBER

DATE MAILED: 06/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/645,660	Applicant(s) MENA, JESUS	
	Examiner Philip C. Lee	Art Unit 2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2152

1. This action is responsive to the amendment and remarks filed on March 24, 2006.
2. Claims 1-3 and 5-22 are presented for examination.
3. The text of those sections of Title 35, U.S. code not included in this office action can be found in a prior office action.

Claim Rejections - 35 USC 103

4. Claims 1-3, 5, 8 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones, III et al, U.S. Patent 6,925,441 (hereinafter Jones) in view of Katz et al, U.S. Patent 6,055,513 (hereinafter Katz).
5. Jones and Katz were cited in the last office action.
6. As per claim 1, Jones taught the invention substantially as claimed comprising:
one or more subscriber servers for collecting information identifying a user and
providing a first data set of user information (col. 9, lines 45-47; col. 13, lines 20-25);
and
a processor (i.e. inherently comprised) in operative communication with the one or more subscriber servers and receiving said first data set from the one or more

subscriber servers and a second data set with demographic data (col. 9, lines 49-55; col. 13, lines 31-36),

said processor including a rule processor receiving said first data set and said second data set and applying said first and second data sets to one or more rules to determine a score predicting behavior relating to said collected information identifying said user (col. 13, line 62-col. 14, line 16; col. 15, lines 37-45).

7. Jones did not teach said second data set is provided by one or more demographic database. Katz taught a similar system comprising:

a processor in operative communication with one or more demographic databases and receiving a second data set from the one or more demographic databases (fig. 2; col. 18, line 40-col. 19, line 15; col. 23, line 6-19); and

one or more demographic databases having third party information relating to targeted market segments and providing a second data set of said third party information relating to targeted market segments (col. 8, lines 63-col. 9, lines 2; col. 9, line 65-col. 10, line 19; col. 18, line 40-col. 19, line 15; col. 23, lines 6-19).

8. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Jones and Katz because Katz's system of receiving a second data set from one of more demographic databases would increase the efficiency of Jones's system by allowing third party database (e.g. demographic database) to provide responsive, effective information to system for marketing determination (col. 10, lines 15-19).

9. As per claim 14, Jones taught the invention substantially as claimed comprising the steps of:

receiving from one or more subscriber servers user-identifying indicia and providing a first data set of user information (col. 9, lines 45-47; col. 13, lines 20-25); and applying said first data sets and a second data set with demographic data to one or more rules to determine a score predicting behavior relating to the user-identifying indicia (col. 13, line 62-col. 14, line 16; col. 15, lines 37-45).

10. Although, Jones taught the score attributable to particular consumer rates the likelihood of that particular consumer responding to an offer of goods and services from merchants (col. 3, lines 51-55), however, Jones did not teach communicating the score with subscriber servers. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include communicating the predictive score to one or more subscriber servers because by doing so it would increase the efficiency of Jones's system by allowing subscriber servers to target consumers with predictive scores that indicate the target consumers have a high likelihood to respond to an offer.

11. Jones did not teach said second data set is provided by one or more demographic database. Katz taught a similar system comprising:

generating from the user-identifying indicia a key which corresponds to values indexed by one or more demographic databases having third party information (col. 9, lines 47-57; col. 22, lines 51-67); communicating the key to the one or more demographic databases (col. 9, lines 47-57; col. 22, lines 51-67); and receiving from the one or more demographic databases demographic information relating to the user-identifying indicia and providing a second data set (col. 8, lines 63-col. 9, lines 2; col. 9, line 65-col. 10, line 19; col. 18, line 40-col. 19, line 15; col. 23, lines 6-19).

12. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Jones and Katz because Katz's system of receiving a second data set from one of more demographic databases would increase the efficiency of Jones's system by allowing third party database to provide responsive, effective information to system for marketing determination (col. 10, lines 15-19).

13. As per claim 2, Jones and Katz taught the invention substantially as claimed in claim 1 above. Katz further taught wherein the processor receives the first data set of user information from one of the subscriber servers and generates a unique key corresponding to the collected information identifying a user (col. 9, lines 47-57; col. 22, lines 51-67).

Art Unit: 2152

14. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Jones and Katz because Katz's system of generates a unique key corresponding to the collected information identifying a user would increase the security of Jones's system by preventing confidential information identifying a user to be easily accessed by identity thief.

15. As per claim 3, Jones and Katz taught the invention substantially as claimed in claim 2 above. Jones further taught wherein the one or more subscriber servers communicate to the processor said first data set of user information about the user based on information identifying the user (col. 9, lines 45-47; col. 13, lines 20-25).

16. As per claim 5, Jones and Katz taught the invention substantially as claimed in claim 1 above. Although, Jones taught the score attributable to particular consumer rates the likelihood of that particular consumer responding to an offer of goods and services from merchants (col. 3, lines 51-55), however, Jones did not teach communicating the score with subscriber servers. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include communicating the predictive score to one or more subscriber servers because by doing so it would increase the efficiency of Jones's system by allowing subscriber servers to target consumers with predictive scores that indicate the target consumers have a high likelihood to respond to an offer.

Art Unit: 2152

17. As per claim 8, Jones and Katz taught the invention substantially as claimed in claim 2 above. Katz further taught wherein the unique key corresponds to values indexed by the one or more demographic databases (col. 9, line 47-col. 10, line 7).

18. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Jones and Katz because Katz's system of the unique key corresponding to values indexed by the one or more demographic databases would increase the security of Jones's system by preventing confidential information identifying a user to be easily accessed by identity thief.

19. Claims 6-7 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones and Katz in view of Lazarus et al, U.S. Patent 6,134,532 (hereinafter Lazarus).

20. Lazarus was cited in the last office action.

21. As per claims 6 and 7, Jones and Katz taught the invention substantially as claimed in claim 5 above. Jones and Katz did not specifically teach using the score for selectively marketing products and service. Lazarus taught wherein the one or more subscriber servers use the score communicated by the processor to selectively market products and services to the user (col. 22, lines 45-64).

Art Unit: 2152

22. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Jones, Katz and Lazarus because Lazarus's method of using the score for selectively marketing products and service would increase the effectiveness of Jones's and Katz's system by allowing targeted information such as advertisement to presented based on a behavior basis to increase the customer response (col. 1, lines 11-13; col. 7, lines 22-27).

23. As per claims 17 and 19, Jones and Katz taught the invention substantially as claimed in claims 1 and 14 above. Jones and Katz did not specifically the score indicating a higher likelihood that the user will make a purchase. Lazarus taught determining a score to select an advertisement based on the user's propensity to make a purchase (col. 19, lines 9-15; col. 22, lines 52-57; col. 25, lines 8-15).

24. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Jones, Katz and Lazarus because Lazarus's method of using the score for indicating a likelihood that the user will make a purchase would increase the alertness of the seller by allowing product and service to be targeted to potential user based on the score.

25. As per claim 18 and 20, Jones and Katz taught the invention substantially as claimed in claims 1 and 14 above. Jones and Katz did not teach using a neural network. Lazarus taught wherein the score is determined using a neural network (col. 20, lines 43-45).

26. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Jones, Katz and Lazarus because Lazarus's method of determining a score using a neural network would increase the flexibility of Jones's and Katz's systems by allowing score to be determined using other types of method as a design choice of the user.

27. Claims 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones and Katz in view of Gerace, U.S. Patent 5,848,396 (hereinafter Gerace).

28. Gerace was cited in the last office action.

29. As per claims 15 and 16, Jones and Katz taught the invention substantially as claimed in claim 14 above. Jones and Katz did not specifically detail type of applications based on the score. Gerace taught the step of the subscriber server determining whether or not to offer a user a product based on the score (abstract; col. 2, lines 46-53).

30. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Jones, Katz and Gerace because Gerace's system of determining whether or not to offer a user a product based on the score would increase the likelihood of selling a product in Jones's and Katz's systems by targeting users with score indicating a tendency to purchase similar product.

31. Claims 9-13 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones and Katz in view of “Official Notice”.

32. As per claims 9-12, Jones and Katz taught the invention substantially as claimed in claims 2 and 8 above. Although, Katz taught wherein the unique key comprises Social Security Number (col. 9, lines 22-57; col. 22, lines 57-67), however, Jones and Katz did not specifically detailing other type of unique keys. “Official Notice” is taken for the concept of other type of unique keys is known and accepted in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include other type of unique keys because by doing so it would increase the flexibility of the user by using different type of keys as a design choice.

33. As per claim 13, Jones and Katz taught the invention substantially as claimed in claim 1 above. Although, Jones and Katz taught wherein

the one or more demographic databases are coupled to the Internet (see Katz, col. 19, lines 41-49; col. 17, lines 4-7); and

the offer is made through the Internet (see Jones, col. 16, lines 21-25), however, Jones and Katz did not specifically detailing the subscriber servers and the processor are coupled to the Internet. “Official Notice” is taken for the concept of subscriber servers and processor coupling to the Internet is known and accepted in the art. It would have been obvious to one of ordinary

Art Unit: 2152

skill in the art at the time the invention was made to include subscriber servers and processor coupled to the Internet because by doing so would increase the field of use in their invention.

34. As per claims 21 and 22, Jones and Katz taught the invention substantially as claim in claims 1 and 14 above. Although, Jones taught third party information (col. 9, lines 49-55), however, Jones and Katz did not specifically detailing other type of third party information. "Official Notice" is taken for the concept of including other type of third party information such as gender and occupation of the user is known and accepted in the art. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to include the other type of third party information to increase the field of use.

35. Applicant's arguments filed 3/24/06 have been fully considered but they are not persuasive.

36. In the remarks, applicant argued that:

- (1) the cited prior arts fail to disclose or suggest a first and second database as claimed.
- (2) the cited prior arts fail to teach applying first and second data sets to rules as claimed.
- (3) Katz does not teach receiving a first data set from one or more subscriber servers and a second data set from one or more demographic databases.

- (4) the cited prior arts do not teach determining a score via a rule processor applying rules to a first and second data set.
- (5) Neither Jones nor Katz teach applying said first and second data sets to one or more rules to determine a score predicting behavior as recited in claim 14.
- (6) the art itself does not suggest such a modification or combination.
- (7) “Official Notice” may not be relied upon and requests references supporting the “Official Notice”

37. In response to point (1), applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., first and second database) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

38. In response to points (2), (4) and (5), Jones taught determining a score by applying calculation (rules) to customer transaction data (first data set) and demographic data (second data set) (fig. 6; col. 13, lines 19-46; col. 15, lines 37-45). Jones clearly states that the score is strictly related to customer's purchasing habits and customer's spending (col. 15, lines 36-45), certainly “purchasing habits” is considered the “behavior” of the user. Accordingly, Jones taught applying first and second data sets to rules to determine a score predicting behavior via a processor (the processor must be inherently comprised in order to perform the calculation).

39. In response to point (3), applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Katz, alone, did not teach receiving a first data set from one or more subscriber servers and a second data set. The combination of Jones and Katz taught receiving a first data set from one or more subscriber servers and a second data set from one or more demographic databases. Specifically, Jones taught receiving a first data set from a subscriber server (col. 9, lines 49-55; col. 13, lines 31-36) and a second data set (114, fig. 6; col. 13, lines 31-33, 40-44). Jones taught a second data set but did not teach provided by a demographic database. Katz taught data set provided by a demographic database (col. 18, line 40-col. 19, line 15; col. 23, lines 6-19). Thus, Jones in view of Katz taught receiving a first data set from one or more subscriber servers and a second data set from one or more demographic databases.

40. In response to point (6), The motivation to combine teachings of Jones and Katz was taught by Katz, itself. Specifically, Katz taught third party database provide “effective” information (col. 10, lines 15-19). By providing “effective” information is certainly considered as “improving the efficiency”. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Jones and Katz because Katz’s system of receiving a second data set from one of more demographic databases would increase the efficiency of Jones’s system by allowing third party database (e.g. demographic

database) to provide responsive, effective information to system for marketing determination (col. 10, lines 15-19).

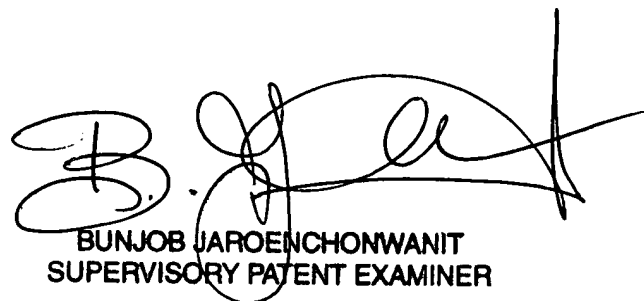
41. In response to point (7), Liu et al, U.S. Patent Application Publication 2004/0249817 [paragraphs 54, 121, 125 and 174], Campbell et al, U. S. Patent Application Publication 2002/0111942 [paragraph 100], Lu et al, U.S. Patent Application Publication 2003/0076930 [paragraph 61], and Pauschinger, U.S. Patent 6,523,014 [col. 4, lines 16-20] are supporting references for the "Official Notice" taken in claims 9, 10 and 12 above. Daleen et al, U.S. Patent 6,493,722 [col. 4, lines 49-50; col. 6, lines 12-41], Jenkins, U.S. Patent 6,285,983 [col. 4, lines 4-61] and O'Flaherty et al, U.S. Patent 6,275,824 [col. 1, line 66-col. 2, line 3] are supporting references for the "Official Notice" taken in claims 21 and 22 above.

42. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Lee

Art Unit: 2152

whose telephone number is (571) 272-3967. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

Philip Lee



BUNJOB JAROENCHONWANIT
SUPERVISORY PATENT EXAMINER